

U.S. Serial No. 10/754,812

Response to the Restriction/Election Requirement of March 17, 2006

**REMARKS**

Claims 1-30 are pending and at issue in the above identified patent application. Of the claims at issue, claims 1, 16, 23, and 28 are independent. The examiner alleges claims 1-30 are directed to five distinct Species. Specifically, the examiner requires a restriction election between figures 1-5 and 9 (Group I), figures 6-8 (Group II), figures 10-15 (Group III), figures 16-21 (Group IV), and figures 22-28 (Group V). As set forth in detail below, without denying that the claims are patentably distinct, the applicants traverse this species restriction requirement. Subject to that traversal and in accordance with the requirements of 37 C.F.R. § 1.143, the applicants hereby provisionally elect Species I. Furthermore, the applicants respectfully submit that each of independent claims 1, 16, and 28 is generic to all alleged species, as none of the identified independent claims excludes any of "a spring retention system and a straight track" (Group I), "a spring retention system and a curved track and a stop" (Group II), "a track and a slider" (Group III), "two engaging tracks" (Group IV), or "a roller and a track" (Group V). Finally, it is also respectfully submitted that the because each of the identified independent claims are generic to the elected species, "a reasonable number" of species claims dependent therefrom should also be considered. (See 37 CFR § 1.141, stating that "a reasonable number, [of species claims] may be specifically claimed in different claims [provided that] all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.") Therefore, it is respectfully noted that claim 1-22 and 28-30 read upon the elected species.

The applicants note, however, that the examiner attempts to support a requirement for restriction between species by simply concluding that the species are independent or distinct. As an initial matter, MPEP §802.02 clearly defines a restriction as "requiring an applicant to elect a single claimed invention (c.g., a combination or subcombination invention, a product or process invention, a species within a genus) for examination..." (MPEP §802.02,

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emphasis added). Thus, a requirement to elect a species is a restriction and, therefore, the criteria for making a restriction apply to an election of species. Per MPEP §803 the criteria for making a restriction are: (1) the inventions must be independent or distinct and (2) there must be a serious burden on the examiner if a restriction is not required. To that end “[e]xaminers must provide reasons and/or examples to support conclusions...” (MPEP 803).

The examiner has provided no reason and/or example as to why each of the alleged species is independent or distinct. As such, the Office action does not put the applicants in a position to meaningfully address the election requirement because the action is devoid of rationale regarding the required criteria for restriction. Therefore, the Office action clearly fails to meet the first requirement of M.P.E.P. § 803 and, on this basis alone, the restriction requirement must be withdrawn.

Furthermore, the M.P.E.P. clearly and unequivocally states that there are two criteria which must be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803). In this instance, regardless of why the examiner concludes that the species are independent or distinct, the examiner fails to allege, let alone demonstrate that a serious burden would be placed on the examiner if election were not required. Accordingly, the applicants respectfully submit that no matter what the rationale for independent or distinct species, there can be no serious burden upon the examiner in reviewing all of the claims simultaneously, because the examiner will likely be searching a single class/subclass in full anyway in reference to any elected one of the species.

If there is a serious burden in the present application, it is on the assignee of this application as a result of this species restriction requirement. Unless the restriction requirement is withdrawn, the assignee must not only prosecute as many as five separate applications, which multiplies the cost and time of obtaining protection for the inventive

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subject matter, but it must also then pay separate maintenance fees for each of the issued patents. It is respectfully submitted that the burden of the expense incurred in order to obtain five different patents and the further expense in maintaining those patents suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

In summary, the Office action fails meet the requirements of M.P.E.P. § 803. In view of the following mandate, this failure renders the restriction requirement improper:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). Therefore, the applicants request that the requirement for restriction be withdrawn.

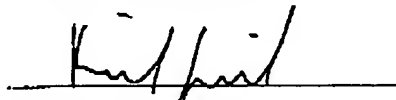
#### Conclusion

In making this election, the applicants do not intend to abandon the scope of non-elected claims, but may pursue the non-elected claims in a divisional application if the restriction requirement is not withdrawn upon reconsideration.

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,  
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